

understand the point of having fly boxes that are removable if they can be accessed without removal. They are removable because, at different seasons or different times of the day, a fly fisherman will want to have a different set of flies, and the removability allows him to simply replace one box with another. It is advantageous to be accessible without being removed because a person normally only has two hands, and as any fly fisherman knows, one hand is often being used for one thing, such as holding a branch or a rod, while one is trying to access a fly box.

The Office Action rejects claims 1 – 18, 23 and 24 under 35 U.S.C. 112, first paragraph, on the basis that the drawing in the application could support the amendment of the base piece covering less than 50% of said chest in a normal adult human and the fly boxes being accessed without removing them from the base piece allegedly does not appear in the disclosure. In the interview, the examiner mentioned that the drawing cannot be relied on for this matter, because patent drawings are not intended to be accurate dimensionally. This rejection is respectfully traversed. The preferred dimensions of the base piece are stated at page 10, lines 18 – 29, and the size of a normal adult chest is something well known in the art, and also something for which official notice can be taken. The dimensions cited in the patent application are well under 50% of the area of the chest of even a small adult human, so that these dimensions together with the drawing do support the amendment. A fly box shown being accessed without removing it from the base piece is shown in FIG. 9 and discussed on page 2, lines 3 and 4, page 15, lines 3 – 6 and other places.

The Office Action rejects claims 1 – 18 and 23 – 25 under 35 U.S.C. 112, second paragraph, as being indefinite because it recites that the fastener releasably secures any one of a plurality of fly boxes to the base piece so they can be accessed without removing them from the base piece. The examiner states that this is confusing since “what is the point of having the fly boxes removable if they can be accessed without removal”. This rejection is respectfully traversed. The fly box must be accessible without removing it so that the fisherman can change flies while fishing where the fly box cannot easily be removed, for example in the middle of a stream. The fly box is removable because fly

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fishermen will, at different times of the year, or even at different times of a day, use a completely different assortment of flies. This allows the fisherman to substitute a different assortment without manually transferring flies from one container to another. For example, one type of fly may mimic an insect that typically is active during the heat of the day, and another type of fly may mimic an insect that begins to hatch during a cooler part of the day. The invention permits the fisherman to quickly adjust to the particular insect that the fish are taking.

The Office Action rejects claims 1 – 12, 23 and 24 under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 4,529,112 issued to George A. Miller (hereinafter “Miller”) in view of United States Patent No. 2,817,472 issued to M.D. Parkhurst (hereinafter “Parkhurst”). This rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991). MPEP 4142 and MPEP 2143 – 2143.03.

Neither Miller nor Parkhurst disclose a harness that secures the base piece to the chest of a fisherman. The examiner says it would be obvious to secure the base piece of Miller to the chest by shortening the strap 11. However, there is no disclosure in either Parkhurst or Miller to shorten the strap of Parkhurst. The suggestion or motivation for modifying a reference must come from the references themselves. MPEP 2143.01. Moreover, even if the strap of Parkhurst were shortened, the base piece of the tackle box would not rest on the front of the chest. In that case, the fishing rod would be in the user’s face and when the user opened it, the arm of the user would interfere with it. No one would use Parkhurst on the front of their chest.

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Secondly, there is no motivation in either Miller or Parkhurst to combine their teachings to reach the claims as amended. In the amended claims, the fastener for releasably securing is formed from the same structural elements as the hinge. In Parkhurst, the fastener is a loop of fabric. In Miller, the hinge is a metal pin. Nothing in either reference or their combination suggests that a fabric loop of Parkhurst should be substituted for the metal pin of Miller. Further, the tackle box of Miller is not a pocket-sized fly box. There is no motivation in either reference or their combination to mount the small tubes of Parkhurst, which the Office Action indicates is a pocket-sized fly box, in the contraption of Miller so it can be moved from a position at the side to a position in the front. The motivation for the combination comes from the present invention, not the references.

Thirdly, the fastener for releasably securing the fly box so that it can be accessed without removing it is not shown in either reference, and the combination is not suggested in either reference or their combination. As discussed above, the examiner did not even know why this element was desirable. How can the examiner in one breath reject a limitation for not being understandable, and in the next breath reject it for being obvious?

With respect to claims 2 – 18, these claims depend on a patentable claim and therefore are also patentable. Further claims 2 – 4, 7 – 12, 23 and 24 contain limitations that are not in either reference, nor suggested in their combination. The Office Action admits that some of these elements are not shown but states that they are obvious without any supporting references. These rejections are specifically traversed and references or an affidavit of the examiner are respectfully requested as required by the MPEP. It is noted that the examiner has indicated that claims 13 – 18 are allowable.

The Office Action rejects claim 25 under 35 U.S.C. 103(a) as being obvious over Miller. This rejection is respectfully traversed. Miller does not show a fastener adapted to releasably secure a fly box to said base piece. The examiner does not even mention this limitation. The MPEP expressly states that all claim limitations must be considered. MPEP 2143.03. On this basis alone, the rejection is improper.

Secondly, the Office Action gets to the limitation that the fly box is accessed when the rod is in a horizontal position by suggesting that if the rod in FIG. 4 is tilted forward,

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which can only be done if the user tilts forward at an awkward angle, the tackle box can be opened slightly without spilling its contents. Opening the tackle box slightly is not accessing it. Perhaps more importantly, this preposterous combination of movements is not suggested in Miller. This is a modification of Miller, and the MPEP requires that the modification be disclosed in the reference.

The examiner admits that Miller does not show the fly box support and fishing rod holder made of a single piece of rigid material, but says it would have been obvious to do this since the function is the same and no stated problem is solved and cites *In re Larson et al.*, 144 USPQ 347. Larson et al. does not support this. In Larson et al., the prior art showed devices that performed the claimed function, i.e., "transmit heat", just as well as the claimed invention. Here, the limitation "single piece of rigid material" is a structural limitation, not a functional limitation. Second, unlike the cited reference in Larson et al., Miller does not suggest any desirable function that the limitation "single piece of rigid material" performs. In other words, the limitation is not suggested in Miller.

Finally, the amended claim requires that the hinge and the fastener that releasably secures the fly box comprise the same structural element. This is another limitation that is not in Miller. Thus, under the MPEP, no *prima facie* case of obviousness is made out.

Based upon the foregoing amendment and remarks, claims 1 – 18 and 23 – 25 as amended are patentable and their reconsideration and allowance are respectfully requested. No fees are seen to be required except the RCE fee. If any additional fee is seen to be required, please charge it to Deposit Account No. 50-1848.

Respectfully submitted,
PATTON BOGGS LLP

By: _____

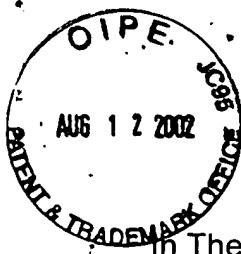


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VERSION WITH MARKINGS TO SHOW CHANGES MADE
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In The Claims:

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Claims 1 and 25 have been amended as follows:

1. (Four Times Amended) A chest fly box ¹⁰⁰ system for holding fishing equipment, comprising:

²⁰ a base piece for supporting a pocket-sized fly box;

³⁰ a harness that secures said base piece to the chest of a fisherman, with said base piece resting on the front of said chest and covering less than 50% of said chest in a normal adult human;

^{222,324} a hinge for permitting movement of said fly box from a horizontal to a vertical position; and

^{222,324} a fastener adapted to releasably secure any one of a plurality of pocket-sized fly boxes to said base piece so they can be accessed without removing them from said base piece, said plurality of pocket-sized fly boxes being of different types;

wherein said hinge and said fastener comprise the same structural element.

25. (Thrice Amended) A portable system for holding, storing and transporting fishing equipment, comprising:

an integrated fly box support and a fishing rod holder made of a single piece of rigid material, said fishing rod holder configured to hold a fishing rod in a horizontal orientation while said fly box is being accessed;

a hinge for permitting movement of said fly box from a horizontal to a vertical position; and

a fastener adapted to releasably secure a fly box to said base piece so it can be accessed without removing it from said base piece;

wherein said hinge and said fastener comprise the same structural element.

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